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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NGUYEN, ALLEN H	

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
05/14/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No.	Applicant(s)	
	10/668,149	ATSUMI, TOMOYUKI	
	Examiner	Art Unit	
	Allen H. Nguyen	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-19 and 22* is/are pending in the application.

4a) Of the above claim(s) *1-13,20 and 21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-19 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the following communication: Amendment filed on 01/23/2009.
- Claims 14-19, 22 are currently pending in the application.

Response to Arguments

1. Applicant's arguments filed 01/23/2009 have been fully considered but they are not persuasive.

2. With respect to applicant's argument that "Shibata, none of the notifications relate to a notification that fax data identified by an identifier is going to be sent".

In reply: Shibata '955 does not explicitly show the send information destination being a destination of send information which includes the identifier and a notification that the fax data identified by the identifier is going to be sent.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Ranalli '639. In particular, Ranalli '639 teaches the send information destination being a destination of send information which includes the identifier (i.e., an identifier of the source fax machine 10 (to which it is attached) and the destination fax number; see col. 5, lines 55-60, figs. 3A-3B) and a notification that the fax data identified by the identifier is going to be sent (The message includes a notification of a non-delivered status, reasons why the document was not delivered, selectable options for redelivery, and a suggestion

as to which option is most appropriate under the circumstances (e.g., request for an alternative delivery number to sent) ; see col. 7, lines 5-60).

In view of the above, having the system of Shibata and then given the well-established teaching of Ranalli, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Shibata as taught by Ranalli to include: the send information destination being a destination of send information which includes the identifier and a notification that the fax data identified by the identifier is going to be sent, since Ranalli stated in col. 8, lines 45-55 that such a modification would enhance a system of sending and receiving modifiable action reports ensures that any undelivered fax is successfully delivered in a faster, more reliable, less-expensive and more automated method.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (US 6,825,955) in view of Ranalli et al. (US 5,790,639).

Regarding claim 14, Shibata '955 discloses a fax data transmission device (Facsimile Apparatus 1, fig. 1) comprising:

a first storing unit (Local Terminal Registration Memory 12, fig. 2) operable to store fax data and an identifier for identifying the fax data (i.e., the local terminal registration memory 12 of the facsimile apparatus 1 includes an information list 30 which contains a plurality of information sets associated with a plurality of local communications terminals; Col. 7, lines 40-45), in correspondence with each other (local terminal information list 30, fig. 3);

a second storing unit (First E-Mail Service Unit 16, fig. 2) operable to store information showing a correspondence between an original destination of the fax data and a send information destination (i.e., the facsimile main controller 10 determines in Step S103 that the E-mail address of the local facsimile apparatus 6 is registered in the local terminal registration memory 12 (YES in Step S103), the facsimile main controller 10 instructs the first E-mail service unit 16 to perform the image data transmission through the E-mail procedure and, then, the first E-mail service unit 16 performs and stores the transmission of E-mail with an attachment of image data; Col. 13, lines 45-55, fig. 9),

a notifying unit (Third E-Mail Service Unit 18, fig. 2) operable to send the send information to the send information destination corresponding to the original destination of the fax data (i.e., the third E-mail service unit 18 to send the E-mail transmission notice to the local facsimile apparatus 6 in Step S105 and to receive the E-mail transmission notice acknowledgment from the local facsimile apparatus 6; Col. 13, lines 55-60, fig. 9), with reference to the information stored

in the second storing unit (the first E-mail service unit 16 controls the third E-mail service unit 18 to send the E-mail transmission notice, col. 13, lines 54-55);

a receiving unit (Receiving Status Manager 11, fig. 2) operable to receive destination information for specifying a destination to which the fax data should actually be sent, as a reply to the send information (i.e., the electronic mail transmitter and receiver to receive an incoming electronic mail upon receiving through the public telephone network an electronic mail transmission notice notifying transmission of the incoming electronic mail from a different facsimile terminal; Col. 2, lines 50-55); and

a sending unit (Transmission Status Manager 11, fig. 2) operable to send the fax data to the destination specified by the destination information (i.e., the facsimile image transmitter and receiver to transmit electronic mail, which is addressed to one of the registered facsimile terminals using the electronic mail address; Col. 2, lines 38-41).

Shibata '955 does not explicitly show the send information destination being a destination of send information which includes the identifier and a notification that the fax data identified by the identifier is going to be sent.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Ranalli '639. In particular, Ranalli '639 teaches the send information destination being a destination of send information which includes the identifier (i.e., an identifier of the source fax machine 10 (to which it is attached) and the destination fax number; see col. 5, lines 55-60, figs. 3A-3B) and a notification that the fax data identified by the identifier is going to be sent (The

message includes a notification of a non-delivered status, reasons why the document was not delivered, selectable options for redelivery, and a suggestion as to which option is most appropriate under the circumstances (e.g., request for an alternative delivery number to be sent) ; see col. 7, lines 5-60).

In view of the above, having the system of Shibata and then given the well-established teaching of Ranalli, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Shibata as taught by Ranalli to include: the send information destination being a destination of send information which includes the identifier and a notification that the fax data identified by the identifier is going to be sent, since Ranalli stated in col. 8, lines 45-55 that such a modification would enhance a system of sending and receiving modifiable action reports ensures that any undelivered fax is successfully delivered in a faster, more reliable, less-expensive and more automated method.

Regarding claim 15, Shibata '955 discloses the fax data transmission device (Facsimile Apparatus 1, fig. 1),

wherein the notifying unit (Third E-Mail Service Unit 18, fig. 2) sends the send information via an Internet mail (i.e., the system comprises an electronic mail generator and transmitter that generates and transmits electronic mail including an attachment file of image data to a communication terminal via the Internet; Col. 3, lines 65-67 and col. 4, line 1),

the receiving unit receives the destination information via a mail replying to

the Internet mail (i.e., a communication system is provided for transmitting and receiving information via a facsimile information communication system and an Internet, such as multipurpose Internet mail extension; Col. 3, lines 62-67).

Regarding claim 16, Shibata '955 discloses the fax data transmission device (Facsimile Apparatus 1, fig. 1), wherein the notifying unit (Third E-Mail Service Unit 18, fig. 2) places the identifier in a message body of the Internet mail (information of the communications report 60, fig. 8).

Regarding claim 17, Shibata '955 discloses the fax data transmission device (Facsimile Apparatus 1, fig. 1),

wherein the destination information includes location information showing a location of an external device (Identification information may include name, desired login name, location information such as address information 30, fig. 3),

the destination to which the fax data should actually be sent is determined based on the location information (a local terminal number 31 representing an identification number to be used within the facsimile apparatus 1, fig. 3).

Regarding claim 18, Shibata '955 discloses the fax data transmission device (Facsimile Apparatus 1, fig. 1), being a multi-functional image forming device which has a copy function of reading a document and forming an image on a recording sheet based on data obtained by reading the document (i.e., the facsimile main controller 10 includes an image reading unit, such as a scanner,

for reading image data from an original document, which is then handled as facsimile image data to be transmitted to the local communications terminals; Col. 6, lines 1-5), and a print function of forming an image on a recording sheet based on incoming data (i.e., the facsimile main controller 10 further includes an image writing unit, such as a laser printer, for printing onto a recording sheet facsimile image data which has been received from one of the local communications terminals; Col. 6, lines 5-10).

Regarding claim 19, Shibata '955 discloses the fax data transmission device (Facsimile Apparatus 1, fig. 1) further comprising:

a notification destination information receiving unit (electronic mail controller 10, fig. 2) operable to receive the information showing the correspondence between the original destination of the fax data and the send information destination, from outside of the fax data transmission device (i.e., the electronic mail controller can control an access call to the Internet server with the electronic mail transmitter and receiver to receive an incoming electronic mail upon receiving through the public telephone network an electronic mail transmission notice notifying transmission of the incoming electronic mail from a different facsimile terminal; Col. 2, lines 55-60),

wherein the second storing unit stores the information received by the notification destination information receiving unit (the first e-mail service unit of the facsimile apparatus 1 receives the E-mail transmission notice

acknowledgment from the destination local communications terminal; Col. 13, lines 45-65).

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (US 6,825,955) in view of Katsuda (US 2002/0059383), and further in view of Ranalli et al. (US 5,790,639).

Regarding claim 22, Shibata '955 discloses a fax data transmission system (electronic communications system including a facsimile apparatus, fig. 2) comprising a fax data transmission device (Facsimile Apparatus 1, fig. 1), an information communication device (Network controller 15, fig. 2), the information communication device including:

a first sending unit (Third e-mail service unit 18, fig. 2) operable to send information showing a correspondence between an original destination of fax data and a send information destination (i.e., the third E-mail service unit 18 reads 06-1234-5678 corresponding to the local terminal number 1 from the facsimile number 33 of the local terminal information list 30. Then, the third E-mail service unit 18 instructs the network controller 15 to initiate a call to 06-1234-5678; Col. 8, lines 62-67, figs. 3, 5), to the fax data transmission device (Facsimile Apparatus 1, fig. 1),

the fax data transmission device including:

a first receiving unit (First E-mail service unit 16, fig. 2) operable to receive the information form the first sending unit (Third e-mail service unit 18, fig. 2) in

the information communication device (i.e., the first E-mail service unit 16 controls services for transmitting and receiving E-mail via the Internet with the help of the dial-up communications controller 13 and the network controller 15; Col. 6, lines 50-55);

a first storing unit (Local Terminal Registration Memory 12, fig. 2) operable to store the fax data and an identifier for identifying the fax data (i.e., the local terminal registration memory 12 of the facsimile apparatus 1 includes an information list 30 which contains a plurality of information sets associated with a plurality of local communications terminals; Col. 7, lines 40-45), in correspondence with each other (local terminal information list 30, fig. 3);

a second storing unit operable to store the information received by the first receiving unit (i.e., the memory registers a plurality of facsimile terminals to be called and stores information sets pertinent; Col. 2, lines 20-25);

a notifying unit (Third E-Mail Service Unit 18, fig. 2) operable to send send information to the send information destination corresponding to the original destination of the fax data (i.e., the third E-mail service unit 18 to send the E-mail transmission notice to the local facsimile apparatus 6 in Step S105 and to receive the E-mail transmission notice acknowledgment from the local facsimile apparatus 6; Col. 13, lines 55-60, fig. 9) with reference to the information stored in the second storing unit (the first E-mail service unit 16 controls the third E-mail service unit 18 to send the E-mail transmission notice, col. 13, lines 54-55),

a second receiving unit operable to receive destination information for specifying a destination to which the fax data should actually be sent, as a reply

to the send information (i.e., the electronic mail transmitter and receiver to receive an incoming electronic mail upon receiving through the public telephone network an electronic mail transmission notice notifying transmission of the incoming electronic mail from a different facsimile terminal; Col. 2, lines 50-55);

a second sending unit operable to send the fax data to the destination specified by the destination information (i.e., the facsimile image transmitter and receiver to transmit electronic mail, which is addressed to one of the registered facsimile terminals using the electronic mail address; Col. 2, lines 38-41),

Shibata '955 does not explicitly show the portable communication device including: a third receiving unit operable to receive the send information from the notifying unit in the fax data transmission device, when designated as the send information destination; and a replying unit operable to send the destination information to the fax data transmission device.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Katsuda '383. In particular, Katsuda '383 teaches the portable communication device including:

a third receiving unit (Portable Telephone 200, fig. 1) operable to receive the send information from the notifying unit in the fax data transmission device (i.e., the portable telephone 200 can acquire the location information and the service information of image output devices located nearby; Page 6, paragraph [0106]), when designated as the send information destination (i.e., multiple image output devices within a prescribed distance of the portable telephone 200 are searched based on the location information of the portable telephone 200

acquired; Page 6, paragraph [0110], fig. 16);

a replying unit (GPS 210, fig. 14) operable to send the destination information to the fax data transmission device (i.e., the location information of the destination of the E-mail and selects an image output device that is most suitable for outputting images from multiple choices of image output devices based on the location information of the acquired portable terminal unit; Page 1, paragraph [0014]).

In view of the above, having the system of Shibata and then given the well-established teaching of Katsuda, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Shibata as taught by Katsuda to include: the portable communication device including: a third receiving unit operable to receive the send information from the notifying unit in the fax data transmission device, when designated as the send information destination; and a replying unit operable to send the destination information to the fax data transmission device, since Katsuda stated on page 1, paragraph [0010] that such a modification would ensure a system to provide an E-mail control apparatus that reduces the operating burden of the user in changing and locating the image output device.

The combination of Shibata '955 and Katsuda '383 does not explicitly show the send information including the identifier and a notification that the fax data identified by the identifier is going to be sent.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Ranalli '639. In particular, Ranalli '639 teaches the send

information including the identifier (i.e., an identifier of the source fax machine 10 (to which it is attached) and the destination fax number; see col. 5, lines 55-60, figs. 3A-3B) and a notification that the fax data identified by the identifier is going to be sent (The message includes a notification of a non-delivered status, reasons why the document was not delivered, selectable options for redelivery, and a suggestion as to which option is most appropriate under the circumstances (e.g., request for an alternative delivery number to be sent) ; see col. 7, lines 5-60).

In view of the above, having the combination system of Shibata and Katsuda and then given the well-established teaching of Kumar, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the combination system of Shibata and Katsuda as taught by Kumar to include: the send information destination being a destination of send information which includes the identifier and a notification that the fax data identified by the identifier is going to be sent, since Ranalli stated in col. 8, lines 45-55 that such a modification would enhance a system of sending and receiving modifiable action reports ensures that any undelivered fax is successfully delivered in a faster, more reliable, less-expensive and more automated method.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yue et al. (US 5,937,050) discloses method for identifying the source of a facsimile communication.

Itoh (US 6,850,972) discloses the image data transmitted from the facsimile apparatus in response to the acquisition request by the image data acquisition request notification step.

Okada et al. (US 2002/0018237) discloses network printer.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen H. Nguyen whose telephone number is (571)270-1229. The examiner can normally be reached on 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KING Y. POON can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 2625

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